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Rappas

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE **RECEIVED**

In re Application of:  
Thomas B. Carlson

Serial No.: 09/788,334

Filed: February 16, 2001

For: PLANTS AND SEEDS OF CORN  
VARIETY I015011

Group Art Unit: 1638

MAY 01 2003

Examiner: Mehta, A.

TECH CENTER 1638 2900

Atty. Dkt. No.: DEKA:282US/REH

CERTIFICATE OF MAILING 37 C.F.R. 1.8	
I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231, on the date below:	
April 23, 2003	
Date	Robert E. Hanson.

**I. INTERVIEW SUMMARY; AND II. RESPONSE TO FINAL OFFICE ACTION**  
**DATED JANUARY 23, 2003**

**BOX AF**

Commissioner for Patents  
Washington, D.C. 20231

Sir:

This paper is submitted in response to the final Office Action dated January 23, 2003, for which the three-month date for response is April 23, 2003. No fees are believed to be due in connection with the instant paper, however, should such fees be due consider this paragraph a request and authorization to withdraw the appropriate fee under 37 C.F.R. §§ 1.16 to 1.21 from *Fulbright & Jaworski, L.L.P.* Account No. 50-1212/DEKA:282US.

Reconsideration of the application is respectfully requested.

## **I. INTERVIEW SUMMARY**

On April 10, 2003, the undersigned participated in a telephonic Interview with Examiner Mehta and the Examiner's supervisor, Examiner Nelson. Applicants would like to thank the Examiners for taking the time for the interview.

The pending rejections were discussed. The written description rejection of claim 31 was discussed in particular. It was communicated that it is the belief of the Examiners that the rejection is proper in that written description of a method claim is viewed identically to that of a composition claim and that each step in a method claim is viewed separately. It was thus indicated that written description must be presented for a corn plant that is produced at each step of the claimed method of producing an inbred corn plant derived from the corn variety I015011 in the same manner as if the product of each individual step was claimed as a composition of matter. No agreement was reached.

## **II. RESPONSE TO FINAL OFFICE ACTION**

### **A. Status of the Claims**

Claims 1-31 were filed with the original application and pending at the time of the Action. No amendments have been made herein. Claims 1-31 are therefore presented herein for reconsideration. A clean copy of the pending claims is provided in Appendix A.

### **B. Rejection of Claims Under 35 U.S.C. §112, Second Paragraph**

The Action maintains the rejections of claims 3, 4, 14 and 21 under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out the subject matter which Applicant regards as the invention.

With regard to the rejection of claims 3, 4 and 14, Applicants submit that the claims are not indefinite as set forth in the previous Response to Office Action, which is herein incorporated by reference.

With regard to claim 21, it is noted that the claim reads as follows:

21. A process of producing corn seed, comprising crossing a first parent corn plant with a second parent corn plant, wherein one or both of the first or the second parent corn plant is a plant of the corn variety I015011, wherein a sample of the seed of the corn variety I015011 was deposited under ATCC Accession No. PTA-3224, wherein seed is allowed to form.

The Action appears to have two objections to the claim: (1) that it uses the term "comprising" and thus could allegedly include other steps, and (2) that claim 22 further defines the method of claim 21 as a process of producing F1 hybrid corn seed and thus claim 21 could include other steps.

With regard to the first issue, it is noted by Applicants that the rejection applies to any use of open language, because certain steps could allegedly be added to any claim in which the transition "comprising" is used. That is, anytime "comprising" is the transition, as it is in the overwhelming majority of claims issued by the USPTO, other steps could be envisioned. For example, a claim to a composition comprising components A and B would be infringed by a composition containing A and B but to which any number of other, unspecified components had been added. Similarly, a claim to a method comprising steps A and B would be infringed by a process involving steps A and B, regardless of whether steps C and D were later carried out. However, what is relevant under 35 U.S.C. §112, second paragraph, is that one of skill in the art be able to understand the metes and bounds of what is claimed. The steps in the instantly claimed process of producing corn seed have been fully recited and thus the metes and bounds of the claim are fully set forth. It has not been alleged that any essential steps are missing or that

any of the steps listed are incomplete. All of the steps are recited and clear. The claim is thus fully definite.

With regard to the second issue, it is noted that claim 21 is not limited to crossing corn plant I015011 with itself. The claim is written in alternative form to include the situation where both parent plants are of corn variety I015011, as well as where one of the parents is a plant other than corn variety I015011. Claim 22 narrows this by specifying the situation to where only one parent corn plant is I015011. The claim is therefore fully definite and the addition of the limitation of "F1" before "corn seed" would be inconsistent with the language of the claim.

In view of the foregoing, removal of the rejections under 35 U.S.C. §112, first paragraph is respectfully requested.

**C. Rejection of Claims Under 35 U.S.C. §112, First Paragraph – Written Description**

The Action rejects claims 3, 4, 14, 21 and 24-31 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to convey that Applicants were in possession of the claimed invention. Applicants respectfully traverse.

With regard to the rejection of claims 3, 4, 14, and 24-30, Applicants submit that the claims do not lack written description for the reasons submitted in the previous Response to Office Action, which are incorporated herein by reference.

With regard to claim 31, Applicants respectfully request that the Office set forth the legal basis for the rejection. As set forth above, Applicants understand from a telephonic interview that it is the position of the Office that written description must be provided for each intermediate product in a method claim in the same manner as if the particular product was individually

claimed as a composition of matter. That is, Applicants understand that the position taken is that it is not sufficient to describe all of the starting materials for a process and all of the steps carried out on the starting materials, but rather that the structural characteristics of any product made at any intermediate step must be described as if claimed as compositions of matter. However, Applicants respectfully disagree with this legal contention and ask that the position and legal basis therefor be set forth with citation to the relevant legal authorities, as this has not been described in an office action. Such an explanation is necessary so that Applicants may adequately and fully respond to the rejection.

As set forth in the USPTO Written Description Guidelines, a description as filed is presumed to have an adequate written description and the Examiner must present a preponderance of evidence to the contrary to maintain a written description rejection. 66 Fed. Reg. 1099, 1107; *citing In re Marzocchi*, 439 F.2d 220, 224 (CCPA 1971) and *In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976). The basis has not been provided for the rejection of claim 31. Applicants therefore respectfully request that the rejection and legal authority on which it is made be explained on the record.

With regard to claim 21, Applicants also request that the basis of the rejection be explained on the record so that an adequate response may be made. Claim 21 reads as follows:

21. A process of producing corn seed, comprising crossing a first parent corn plant with a second parent corn plant, wherein one or both of the first or the second parent corn plant is a plant of the corn variety I015011, wherein a sample of the seed of the corn variety I015011 was deposited under ATCC Accession No. PTA-3224, wherein seed is allowed to form.

Therefore, all that the claim requires is crossing a plant of the corn variety I015011 with itself, including another plant of variety I015011, or any second variety. The latter option is specified in claim 22, but is not required in claim 21 given that the claim is drafted in the alternative. In

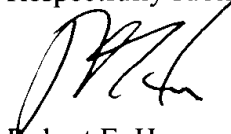
claim 21 either one or both of the parent plants may be from the corn variety I015011. It has not been alleged that corn variety I015011 is not fully described, thus it is assumed that the rejection is made with regard to crossing variety I015011 to a second plant as required in claim 22. However, claim 22 has not been rejected. The basis for the rejection is thus not understood. Applicants therefore respectfully request that the rejection and legal authority on which it is based be explained on the record so that a full response thereto may be made.

**D. Conclusion**

This is submitted to be a complete response to the referenced Office Action. In conclusion, Applicant submits that, in light of the foregoing remarks, the present case is in condition for allowance and such favorable action is respectfully requested.

The Examiner is invited to contact the undersigned at (512)536-3085 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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Date: April 23, 2003

## APPENDIX A: PENDING CLAIMS

1. A seed of the corn variety I015011, wherein a sample of the seed of the corn variety I015011 was deposited under ATCC Accession No. PTA-3224.
2. A population of seed of the corn variety I015011, wherein a sample of the seed of the corn variety I015011 was deposited under ATCC Accession No. PTA-3224.
3. The population of seed of claim 2, further defined as an essentially homogeneous population of seed.
4. The population of seed of claim 2, further defined as essentially free from hybrid seed.
5. A corn plant produced by growing a seed of the corn variety I015011, wherein a sample of the seed of the corn variety I015011 was deposited under ATCC Accession No. PTA-3224.
6. The corn plant of claim 5, having:
  - (a) an SSR profile in accordance with the profile shown in Table 5; or
  - (b) an isozyme typing profile in accordance with the profile shown in Table 6.
7. A plant part of the corn plant of claim 5.
8. The plant part of claim 7, further defined as pollen.
9. The plant part of claim 7, further defined as an ovule.
10. The plant part of claim 7, further defined as a cell.
11. The plant part of claim 10, wherein said cell is further defined as having :
  - (a) an SSR profile in accordance with the profile shown in Table 5; or
  - (b) an isozyme typing profile in accordance with the profile shown in Table 6.

12. A seed comprising the cell of claim 10.
13. A tissue culture comprising the cell of claim 10.
14. An essentially homogeneous population of corn plants produced by growing the seed of the corn variety I015011, wherein a sample of the seed of the corn variety I015011 was deposited under ATCC Accession No. PTA-3224.
15. A corn plant capable of expressing all the physiological and morphological characteristics of the corn variety I015011, wherein a sample of the seed of the corn variety I015011 was deposited under ATCC Accession No. PTA-3224.
16. The corn plant of claim 15, further comprising a nuclear or cytoplasmic gene conferring male sterility.
17. (A tissue culture of regenerable cells of a plant of corn variety I015011, wherein the tissue is capable of regenerating plants capable of expressing all the physiological and morphological characteristics of the corn variety I015011, wherein a sample of the seed of the corn variety I015011 was deposited under ATCC Accession No. PTA-3224.
18. The tissue culture of claim 17, wherein the regenerable cells comprise cells derived from embryos, immature embryos, meristematic cells, immature tassels, microspores, pollen, leaves, anthers, roots, root tips, silk, flowers, kernels, ears, cobs, husks, or stalks.
19. The tissue culture of claim 18, wherein the regenerable cells comprise protoplasts or callus cells.
20. A corn plant regenerated from the tissue culture of claim 17, wherein the corn plant is capable of expressing all of the physiological and morphological characteristics of the corn



variety designated I015011, wherein a sample of the seed of the corn variety I015011 was deposited under ATCC Accession No. PTA-3224.

21. A process of producing corn seed, comprising crossing a first parent corn plant with a second parent corn plant, wherein one or both of the first or the second parent corn plant is a plant of the corn variety I015011, wherein a sample of the seed of the corn variety I015011 was deposited under ATCC Accession No. PTA-3224, wherein seed is allowed to form.

22. The process of claim 21, further defined as a process of producing F1 hybrid corn seed, comprising crossing a first inbred corn plant with a second, distinct inbred corn plant, wherein the first or second inbred corn plant is a plant of the corn variety I015011, wherein a sample of the seed of the corn variety I015011 was deposited under ATCC Accession No. PTA-3224.

23. The process of claim 22, wherein crossing comprises the steps of:

- (a) planting the seeds of first and second inbred corn plants;
- (b) cultivating the seeds of said first and second inbred corn plants into plants that bear flowers;
- (c) preventing self pollination of at least one of the first or second inbred corn plant;
- (d) allowing cross-pollination to occur between the first and second inbred corn plants; and
- (e) harvesting seeds on at least one of the first or second inbred corn plants, said seeds resulting from said cross-pollination.

24. Hybrid corn seed produced by the process of claim 23.

25. A hybrid corn plant produced by growing a seed produced by the process of claim 23.

26. The hybrid corn plant of claim 25, wherein the plant is a first generation (F<sub>1</sub>) hybrid corn plant.

27. The corn plant of claim 5, further defined as having a genome comprising a single locus conversion.

28. The corn plant of claim 27, wherein the single locus was stably inserted into a corn genome by transformation.

29. The corn plant of claim 27, wherein the locus is selected from the group consisting of a dominant allele and a recessive allele.

30. The corn plant of claim 27, wherein the locus confers a trait selected from the group consisting of herbicide tolerance; insect resistance; resistance to bacterial, fungal, nematode or viral disease; yield enhancement; waxy starch; improved nutritional quality; enhanced yield stability; male sterility and restoration of male fertility.

31. A method of producing an inbred corn plant derived from the corn variety I015011, the method comprising the steps of:

- (a) preparing a progeny plant derived from corn variety I015011 by crossing a plant of the corn variety I015011 with a second corn plant, wherein a sample of the seed of the corn variety I015011 was deposited under ATCC Accession No. PTA-3224;
- (b) crossing the progeny plant with itself or a second plant to produce a seed of a progeny plant of a subsequent generation;
- (c) growing a progeny plant of a subsequent generation from said seed and crossing the progeny plant of a subsequent generation with itself or a second plant; and
- (d) repeating steps (b) and (c) for an addition 3-10 generations to produce an inbred corn plant derived from the corn variety I015011.